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EXAMINER

ROBINSON, KEITH O NEAL

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/665,029

Applicant(s)

WAYCOTT, WILLIAM

Examiner

Keith O. Robinson, Ph.D.

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 38-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 38-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20 May 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I (claims 1-9), the cancellation of claims 10-37 and the addition of new claims 38-45 in the reply filed on 13 July 2005 is acknowledged. In addition, Applicant has elected the patentably distinct species PSR 6425.
2. Claims 1-9 and 38-45 and the patentably distinct species PSR 6425 are under examination.

### ***Claim Objections***

3. Claims 38-43 are objected to because of the following informalities:
  - (a) claim 38, line 1, the phrase "Seed of an iceberg" should read - - A seed of the iceberg - -.
  - (b) claims 39 and 40, the phrase "or parts thereof" should read - - or a part thereof --.
  - (c) claim 41, the "and parts thereof" should read - - or a part thereof --.
  - (d) claim 42, the phrase "Seed produced" should read -- A seed produced -- .
  - (e) claim 43, line 1, the phrase "Iceberg lettuce plants, or parts thereof" should read -- An iceberg lettuce plant, or a part thereof -- .Appropriate correction is required.

### ***Specification Objections***

4. The disclosure is objected to because of the following informalities: The deposit information is objected to because three (3) lettuce lines share the same Deposit Accession Number (i.e. PTA-3248). It is not clear which line is represented by this Accession Number.

Appropriate correction is required.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-4 and 6-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 8-16 of U.S. Patent No. 6,689,941. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are generic to all the groups.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory matter.

Claim 1 is broadly drawn to any iceberg lettuce plant with the limitation only that it comprises a trait of a first outer leaf having a length to width ratio characteristic, wherein said plant may naturally occur, without the requirement of manipulation by the hand of man. Claims 2-7, dependent on claim 1, are broadly drawn to any iceberg lettuce plants with an additional characteristic of either spatulate leaf shape; or elliptical stature; or outer leaf color between RHS 146A and RHS 146B; or blanched inner leaf color between RHS 145C and 145D; or a semi-open head; or resistance to corky root and/or mosaic virus. Leaf length to width ratio, leaf spatulate shape, elliptical stature, semi-open head, and disease resistance are interpreted as quantitative traits or polygenic-encoded traits.

De Vries et al (Plant Syst. Evol. 193: 125-141, 1994) teach a wide diversity of naturally occurring forms of iceberg lettuce, and that this diversity of form includes a wide range of naturally occurring leaf color, plant habit, leaf shape, and that naturally occurring forms comprise a wide range of disease resistance genes (see pages 127 and 129, Tables 1 and 2). Accordingly the plants of claims 1-7 have the same characteristics and utility as those found naturally and therefore do not constitute

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patentable subject matter. See *American Wood v. Fiber Distintegrating Co.*, 90 U.S. 566 (1974), *American Fruit Growers v. Brogdex Co.*, 283 U.S. 2 (1931), *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 33 U.S. 127 (1948), *Diamond v. Chakrabarty*, 206 USPQ 193 (1980).

***Claim Rejections - 35 USC § 112, first paragraph***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-7 and 41-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-7 are broadly drawn to any iceberg lettuce plant having various phenotypic characteristics and methods of making and using said plants.

The specification fails to provide a written description regarding the genetic, morphological, and/or physiological characteristics of the broad genus of iceberg lettuce plants with one or more of the claimed characteristics; therefore, any methods of making or using said plants is not described.

Claims 41-45 are broadly drawn to the uncharacterized progeny of iceberg lettuce plant PSR 6425 and hybrid lettuce plants having at least one parent being PSR 6425.

The specification does not describe the other lettuce plant or plants that are to be crossed with PSR 6425 nor is there a description of their genetic, morphological, and/or physiological background. It is known in the art that any plant produced from the crossing of two different plants will be an F1 hybrid plant that is heterozygous at all loci, therefore, the hybrid plant will contain 50% of the alleles from the PSR 6425 lettuce plant and 50% of the alleles from the other uncharacterized lettuce plant. The PSR 6425 lettuce plant, as well as its seeds and parts thereof, is the claimed invention, so a plant that contains only 50% of the alleles of the PSR 6425 lettuce plant is not the same as the claimed PSR 6425 lettuce plant, which would have 100% of its alleles. Moreover, the genetic, morphological, and/or physiological characteristics of the claimed hybrids are not described in the specification. Since the claimed invention is derived from crossing PSR 6425 with any lettuce plant, there could conceivably be thousands of hybrids, each with different genetic, morphological, and/or physiological characteristics due to each having different "other" parents and the specification does not describe these hundreds of hybrids.

The art teaches that the genetic variation among individual progeny of a breeding cross allows for the identification of rare and valuable new genotypes but that these genotypes are neither predictable nor incremental in value, but rather the result of manifested genetic variation combined with selection methods, environments and the

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actions of the breeder (Kevern US Patent 5,850,009, column 4, lines 41-46); therefore, Applicant has not described the myriad of different hybrids that may be produced from the result of manifested genetic variation combined with selection methods, environments and the actions of the breeder.

The Federal Circuit has recently clarified the application of the written description requirement. The court stated that a written description of an invention "requires a precise definition, such as by structure, formula, [or] chemical name, of the claimed subject matter sufficient to distinguish it from other materials". *University of California v. Eli Lilly and Co.*, 119 F.3d 1559, 1568; 43 USPQ2d 1398, 1406 (Fed. Cir. 1997). The court also concluded that "naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not description of that material". *Id.* Further, the court held that to adequately describe a claimed genus, Patent Owner must describe a representative number of the species of the claimed genus, and that one of skill in the art should be able to "visualize or recognize the identity of the members of the genus". *Id.*

See MPEP Section 2163, page 156 of Chapter 2100 of the August 2001 version, column 2, bottom paragraph, where it is taught that

[T]he claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. A biomolecule sequence described only by a functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence.



Given the failure of the specification to describe the claimed plant, methods of using it are also inadequately described. Accordingly, one skilled in the art would not have recognized Applicants to have been in possession of the claimed invention. See the written description guidelines published in Federal Register/ Vol. 66, No. 4/ Friday January 4, 2001/ Notices: pp. 1099-1111.

10. Claims 1-9 and 38-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims 38-45 are broadly drawn to an iceberg lettuce plant having deposit number PTA-3248. Since the plant is essential to the claimed inventions, it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If the plant is not so obtainable or available, the requirements of 35 U.S.C. 112 may be satisfied by a deposit of the plant. The specification does not disclose a repeatable process to obtain the plant and it is not apparent if the plant is readily available to the public. Thus, a deposit is required, for enablement purposes, of 2500 seed of each of the claimed embodiments is considered sufficient to ensure public availability. If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or

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her signature and registration number, stating that the specific strain has been deposited under the Budapest Treaty and that the strain will be irrevocably and without restriction or condition released to the public upon the issuance of a patent, would satisfy the deposit requirement herein.

If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 C.F.R. 1.801-1.809, applicants may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that

- (a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- (c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer;
- (d) a test of the viability of the biological material at the time of deposit (see 37 C.F.R. 1.807) and,
- (e) the deposit will be replaced if it should ever become inviable.

It is noted that the specification has deposit information (see page 26, paragraphs 00081-00084); however, this information is incomplete. There is no reference regarding the criteria set forth in 37 C.F.R. 1.801-1.809 or any statement by an attorney of record over his or her signature and registration number, showing that the

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above conditions (a)-(e) have been met. Furthermore, it is not apparent which lettuce line is represented by Accession Number PTA-3248, as stated above and a mixed deposit in the instant case is not considered enabling.

*In re Wands*, 858F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988) lists eight considerations for determining whether or not undue experimentation would be necessary to practice an invention. These factors are: the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples of the invention, the nature of the invention, the state of the prior art, the relative skill of those in the art, the predictability or unpredictability of the art, and the breadth of the claims.

Claims 1-9 are broadly drawn to any iceberg lettuce plant having various phenotypic characteristics and methods of making and using said plants.

The specification fails to provide any guidance regarding the genetic, morphological, and/or physiological characteristics of the broad genus of iceberg lettuce plants with one or more of the claimed characteristics; therefore, any methods of making or using said plants are not enabled.

The specification only provides guidance regarding the morphological and/or physiological characteristics of the lettuce breeding lines PSR 6425, PSR 6595 and PSR 6032 (see page 16, paragraph 00059 to page 22 and Tables 3-5).

The specification fails to provide any evidence of the broad genus of iceberg lettuce plants having the claimed characteristics.

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The specification only provides evidence of the lettuce breeding line PSR 6425, PSR 6595 and PSR 6032 having the claimed characteristics (see page 16, paragraph 00059 to page 22 and Tables 3-5).

Claims 41-45 are broadly drawn to hybrid lettuce plants having at least one parent being PSR 6425.

The specification does not provide any guidance with regards to the other lettuce plant or plants that are to be crossed with PSR 6425 nor is there any guidance regarding their genetic, morphological, and/or physiological background. It is known in the art that any plant produced from the crossing of two different plants will be an F1 hybrid plant that is heterozygous at all loci, therefore, the hybrid plant will contain 50% of the alleles from the PSR 6425 lettuce plant and 50% of the alleles from the other uncharacterized lettuce plant. The PSR 6425 lettuce plant, as well as its seeds and parts thereof, is the claimed invention, so a plant that contains only 50% of the alleles of the PSR 6425 lettuce plant is not the same as the claimed PSR 6425 lettuce plant, which would have 100% of its alleles. Moreover, there is no guidance provided in the specification regarding the genetic, morphological, and/or physiological characteristics of the claimed hybrids. Since the claimed invention is produced from crossing PSR 6425 with any lettuce plant, there could conceivably be thousands of hybrids, each with different genetic, morphological, and/or physiological characteristics due to each having different "other" parents and the specification does not describe these hundreds of hybrids in terms of their traits, or provide any guidance regarding their use and

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therefore, it would not enable one skilled in the art to make and/or use the claimed invention.

The art teaches that the genetic variation among individual progeny of a breeding cross allows for the identification of rare and valuable new genotypes but that these new genotypes are neither predictable nor incremental in value, but rather the result of manifested genetic variation combined with selection methods, environments and the actions of the breeder (Kevern, US Patent 5,850,009, column 4, lines 41-46). The nature of the art at the time of Applicant's invention was such that one of skill in the art could not reasonably predict what the product of a cross between two inbred parental plants would be without a reduction to practice. The art teaches that "Even if an inbred in hybrid combination has excellent yield (a desired characteristic), it may not be useful because it fails to have acceptable parental traits such as seed yield, seed size, pollen production, plant height, etc." (Carlone, U.S. Patent 5,763,755, column 2, lines 11-14). The art teaches that based on the number of segregating genes, the frequency of occurrence of any individual with a specific genotype is less than 1 in 10,000 and that even if the entire genotype of the parents has been characterized and the desired phenotype is known, only a few if any individuals having the desired genotype may be found in a large  $F_2$  or  $S_0$  population and that typically the genotype of neither the parents nor the desired genotype is known in detail (see Segebart, U.S. Patent 5,304,719, in particular the paragraph spanning columns 2-3). The art also teaches that the number of genes affecting the trait of primary economic importance can be in the range of 10-1000 and that inbred lines which are used as parents for breeding crosses differ in the

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number and combination of these genes (Segebart, U.S. Patent 5,367,109, column 2, lines 60-64). Segebart ('109) also teaches that one of the largest plant breeding programs in the world does not have a sufficiently large breeding population to be able to rely upon "playing the numbers" to obtain successful research results and that plant breeders use their skills, experience and intuitive ability to select inbreds having the necessary qualities (column 4, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs). Hence, given the fact that one of skill in the art cannot reasonably predict the number of genes that affect the traits of the parental inbred lines of an inbred lettuce plant, it is unclear how one of skill in the art could reasonably predict how to make and use the claimed lettuce plants and methods of making a lettuce plant using a second or filial non-exemplified lettuce plant produced from Applicant's exemplified inbred lettuce plant.

The specification teaches that methods of producing iceberg lettuce plants having various characteristics are unpredictable. The specification states, "With more than 10,000 genes known to exist in plants, it is often highly improbable, if not impossible to converge on all the desired genetic traits in one individual" (see page 5, paragraph 00023). The specification also states that gene interactions "may prevent the expression of a selected desirable trait" (see page 6, paragraph 00024) and that a problem with creating a new variety "includes linkage drag" (see page 6, paragraph 00025).

Ryder et al (J. Amer. Soc. Hort. Sci. 117(3): 504-507, 1992) teach that epistatic interactions between genes which confer a "sickly" phenotype were epistatic to different genes for leaf color, as well as to those genes which confer traits for growth habit and

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leaf shape (see page 505, Tables 1-4; page 506, Table 6; and page 504, first column, line 1 to page 507, second column, line 7).

Given the claim breadth, the lack of guidance regarding the use of the broad genus of iceberg lettuce plants, the lack of evidence regarding the broad genus of iceberg lettuce plants, and the unpredictability of producing iceberg lettuce plants having various characteristics, undue trial and error experimentation would be required by one skilled in the art to make and/or use the claimed invention.

***Claim Rejections - 35 USC § 112, second paragraph***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 44 recites the limitation "said parent line"; however, there is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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15. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Bassett (J. Amer. Soc. Hort. Sci. 100(2): 104-105, 1975).

The claims are broadly drawn to any iceberg lettuce plant comprising an outer leaf with a length to width ratio between 1.2 to 2.7, or an additional trait of plant morphology or disease resistance and a method of making said plants.

Bassett discloses an iceberg lettuce cultivar, namely 'Minetto', with a semi-open head habit comprising 'Gallega' cultivar, and the genetic analysis of F1 and F2 progeny of a quantitative trait leaf width/length ratio, heading habit, and a discrete trait of resistance to lettuce mosaic virus, derived from the *mo* gene of the cultivar 'Gallega'.

Bassett discloses that 'Minetto' has spatulate rounder and wider leaves than 'Gallega', and an elliptical and more closed head (see page 104, second column, lines 10-18).

Basset discloses that the distribution of heading phenotypes in F2 progeny was continuous in most other leaf and stature phenotypes, but that all of the F2 progeny bred tended to comprise a more semi-open head than 'Minetto' and that heads initiated at later times in the growing season, compared to 'Minetto', or other commercial iceberg lettuce cultivars (see page 105, first column, line 15 to second column, line 27).

Basset discloses that at least one of the F2 progeny had a leaf length/width ratio of 1.5 (e.g. the inverse of .75 width/length ratio in Table 1) and comprised an iceberg lettuce plant with a semi-open head, elliptical stature, and spatulate leaf shape (see page 104, second column, lines 10-18 and Table 1). Bassett discloses that from an analysis of populations of F2 progeny, F2 progeny could identified with spatulate leaves,



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semi-open heads, and elliptical stature, with a range of about a 0.74 length/width ratio to about 1.2 length/width ratio (i.e. 1.35 and 0.85 width/length ratios, respectively) (see page 105, second column, lines 4-10 and Table 3).

***Claim Rejections - 35 USC § 102/103***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 41-45 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Basset (J. Amer. Soc. Hort. Sci. 100(2): 104-105, 1975).

The claims read on hybrid seeds and plants thereof produced by crossing with an uncharacterized parent wherein said plant comprises one or more traits of morphology or disease resistance.

Basset teaches that the iceberg lettuce cultivar 'Minetto' has a spatulate leaf shape and is elliptical in stature; and that 'Gallega' comprises a semi-open head and a

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*mo* allele (which confers a phenotype of resistance to lettuce mosaic virus), as discussed in the 35 U.S.C. 102(b) rejection above.

The claimed plants differ from either of the 'Minetto' or 'Gallega' plants taught by Basset only in their derivation from a 'PSR 6425' cross. However, the use of 'PSR 6425' with unspecified breeding partners would not confer a unique characteristic to the claimed plants which would distinguish them from the prior art plants, in view of the loss of PSR 6425-derived genetic material. See *In re Thorpe*, 227 USPQ 964,966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejected over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the products.

### ***Conclusion***

19. Claims 4-5 and 38-40 are deemed free of the prior art given the failure of the prior art to teach or suggest iceberg lettuce plants having a length to width ratio between 1.2 to 2.7, further comprising outer and inner leaf color ranging from RHS 146A to RHS 146B and RHS 145C to RHS145D, respectively, or plants, seeds, and parts thereof of the lettuce plant line PSR 6425.

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20. Claims 1-9 and 38-45 are rejected.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on 571-272-0745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith O. Robinson, Ph.D.

August 10, 2005

DAVID H. KRUSE, PH.D.  
PRIMARY EXAMINER  
